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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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THOMAS M. THIBAUT
11340 VISTA SORRENTO PKWY #306
SAN DIEGO, CA 92130

EXAMINER

WRIGHT, ANDREW D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,594

Applicant(s)

BISTLINE, DONALD A

Examiner

Andrew Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 30-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30 and 36-47 is/are rejected.
- 7) ☒ Claim(s) 31-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species A in the reply filed on 6/22/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicant's withdrawal of claims 1-4 and cancellation of claims 5-29 is acknowledged. Claims 1-4 and 30-47 are now pending.

Drawings

3. The drawings were received on 4/9/04. These drawings are not acceptable. Changes to the drawings must be made by submission of "Replacement Sheets". See below.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the housing sized and shaped to cover a fin mounting fastener (claim 30); the first shaft rotatable about an axis perpendicular to the bottom surface of the housing (claims 33 and 40); the locking mechanism used to rotate the first shaft (claim 34); the depression sized and shaped to accept the fin mounting fastener (claims 35 and 42); placing a housing over the fin mounting fastener (claims 44 and 46); and rotating the first shaft around an axis (claim 47) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The use of the trademark "VELCRO" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

6. Claim 31 is objected to. Claim 31 recites the limitation "the bottom surface of the housing" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. A bottom surface of the housing has not yet been positively recited. The word "the" should be changed to "a". Appropriate correction is required.

7. Claim 33 is objected to. Claim 33 recites the limitation "the bottom surface of the housing" in line 2. There is insufficient antecedent basis for this limitation in the claim. A bottom surface of the housing has not yet been positively recited. The word "the" should be changed to "a". Appropriate correction is required.

8. Claim 35 is objected to. Claim 35 recites the limitation "the bottom surface of the housing" in line 2. There is insufficient antecedent basis for this limitation in the claim. A bottom surface of the housing has not yet been positively recited. The word "the" should be changed to "a". Appropriate correction is required.

9. Claim 36 is objected to. Claim 36 recites "said covering means" when referring to the "means for covering". Suggested wording is "said means for covering". Appropriate correction is required.

10. Claim 37 is objected to. Claim 36 recites "the means for locking said covering means in place" when referring to the "means for locking said covering means to a bottom surface of the sports board". Suggested wording is "said locking means". Appropriate correction is required.

11. Claims 44 and 47 are objected to. The terms "distillate" and "distill" should be replaced with "distal". Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 36-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 36 recites "means for covering ..." and "means for locking ...". Each recitation is a means-plus-function recitation that invokes 35 USC 112 6th Paragraph. The corresponding structure, material, or acts for performing the recited function is not clearly identified in the specification. If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1115-18, 63 USPQ2d 1725, 1731-34 (Fed. Cir. 2002). See MPEP 2181. Claims 37-42 depend from claim 36 and are rejected for the same reason.

15. Claims 37, 38, and 40 recites the limitation "the housing". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 30, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Cartwright (US 5,109,683). Cartwright shows an apparatus that comprises housing (40), first shaft (42), tab (46), second shaft (38), and locking mechanism (60). The housing covers a mast track. The mast track fastens a mast to the board. The mast is part of a sail which constitutes a fin that extends upward. Therefore, the housing can cover a fin mounting fastener. First shaft (42) is perpendicular to the housing. First shaft can extend into a channel. Tab (46) is located at an end of the first shaft. The tab (46) can engage a lip of the channel. Second shaft (38) also extends perpendicular to the housing. Second shaft can also extend in to the channel. Locking mechanism (60) prevents removal of the housing when locked, and allows removal of the housing when unlocked.

18. It is noted that the recitation “for securing a fin to a sports board” is in the preamble. The recitation has not been given patentable weight because it occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the body of the claim does not breath life into the recitation of securing a fin to a board. The body of the claim does not define or

refer to fin. It is suggested that the claim be amended to breathe life in to the preamble recitation.

19. It is also noted that claim 30 has numerous intended use recitations, such as "sized and shaped to cover...", "sized and shaped to extend...", "sized and shaped to engage...". A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant application, the cited art is at least capable of performing the recited intended uses. It is suggested that the intended use recitations be positively recited as structural recitations.

20. Regarding claims 36 and 37, and as best understood in light of the 35 USC 112 2nd rejections described above, the housing (40) constitutes a means for covering a fin mounting fastener and the first shaft, second shaft, tab, and locking mechanism constitute a means for locking.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cartwright (US 5,109,683). Cartwright does not disclose the recited method steps. The method steps, however, are inherent in the making and use of the Cartwright apparatus. Regarding claim 43, the use of the Cartwright apparatus necessarily includes covering mast track (10) with housing (40), and necessarily includes locking the housing to the board with lock (60). Regarding claim 44, the first shaft (42) is inserted into the channel, the first shaft has a tab at a distal end that is parallel to the channel. Regarding claim 45, the first shaft with tab is inserted into entry channel (32) and then the housing is rotated as tab is slid down toward the position shown in figure 4. The tab engages a lip of the channel. Then second shaft is extended into the entry channel and slid to the position shown in figure 4. Then the lock is secured. Regarding claim 46, both the first shaft and second shaft are inserted into the channel, and the first shaft has a tab that is parallel to the channel. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the claimed method steps based upon operation of the apparatus disclosed by Cartwright. The motivation would be to use the apparatus as described by Cartwright.

23. Claims 43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frizzell (US 5,934,963). Frizzell shows a locking apparatus that comprises an object (41). First shaft (40) and second shaft (43) extend from the bottom surface of the object. Tab (47) is located at the distal end of the first shaft (40). In use, the first shaft and second shaft are inserted into a channel (17) of the board. The first shaft is rotated

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about an axis that is perpendicular to the bottom surface of the object (41). The tab engages a lip (18T) in the channel. The object (41) covers a portion of fin box (14) which is a fin mounting fastener. The act of turning the first shaft such that the tab engages the lip constitutes locking the object to the board. Therefore, the recited method steps are inherent in the making and use of the Frizzell apparatus. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the claimed method steps based upon operation of the apparatus disclosed by Frizzell. The motivation would be to use the apparatus as described by Frizzell.

Allowable Subject Matter

24. Claims 31-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jacobi ('261) shows a locking apparatus with a housing and a shaft with a tab. Williams ('376) shows a surfboard fin locking mechanism. Spence ('649) shows a surfboard locking mechanism. McKenzie ('754) shows a surfboard locking mechanism. Tan ('145) shows a surfboard locking mechanism. Tan ('537) shows a surfboard locking mechanism. Thomas ('689) shows a surfboard fin lock.

26. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

AW 9/1/04
ANDREW D. WRIGHT
PRIMARY EXAMINER